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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

CHUNG, JI YONG DAVID

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/993,532	<b>Applicant(s)</b> WILKS, ANDREW W.	
	<b>Examiner</b> Ji-Yong D. Chung	<b>Art Unit</b> 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 and 6 is/are allowed.
- 6) ☒ Claim(s) 8-11, 13, 15-18, and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Remarks***

1. Applicant's arguments and amendments filed on July 21, 2005, referenced in the Request for Continued Examination, dated October 6, 2005 have been carefully considered. They are not deemed fully persuasive.

Applicant's main argument is that there is no motivation to combine the cited references Bourke-Dumpny et al. (Pat. No. US 6,449,642, Bourke hereinafter) and French et al (U.S. Pat. No. 6,442,685, referred to as French hereinafter).

The Office disagrees.

Bourke indicates that a computer name is created in a network setting (the computer name in netparam.ini is used to name the computer (lines 1-13, column 8). See also lines 36-52 of column 6. French indicates that, in lines 27-48 of column 6, adding a computer name, in a given network, can cause name clashes and a way to detect such clash. In implementing Bourke, one would be forced to recognize the name clash problem in light of French and consider using NetBIOS commands to help avoid the problem as explained in French. Simply put, Bourke and French cover overlapping subject matter, in which a potential problem, and its solution are conceptually suggested in French.

***Allowable Subject Matter***

2. **Claims 1-4 and 6** are allowable.

With regard to independent claim 1, its limitation “prior to the boot up of the network of information handling systems” is not shown by the prior art references cited in the prior Office actions. The Office has performed further searches; no prior art references that may render the claimed subject matter anticipated or obvious has been found.

3. The remaining claims cite “a service tag identifier.” According to the specification, the “service tag identifier” may refer to a manufacturer tag, associated with a hardware product.

In the prior Office rejections, the “service tag identifier” has been mapped to a user id or software string in the patent publication to Bourke. The Office’s mapping rests on the idea that, as recited in the claim, the term “service tag identifier” maybe interpreted as identifier or tag included in software or a text file.

If Applicant were to stipulate that term “manufacturer tag” as something different from the mapped item in Bourke, in the Remarks in the next Amendment, or Applicant were to further limit the claims to emphasize the distinction, the remaining claims would be allowable.

Note that any removal or deletion of substantive limitation from the independent claims 8 and 15 in the future Amendment would render the above allowability based on “service tag identifier” moot and would trigger a new set of search and a reconsideration of the claims. One exception is claim 1, which may remove the limitation “but prior to the boot up of the network of

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information handling system,” provided the preceding issue with “service tag identifier” is properly addressed.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 8-11, 13, 15-18, and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bourke-Dunphy et al (U.S. Pat. No. 6,449, 642, referred to as Bourke-Dunphy hereafter) in view of French et al (U.S. Pat. No. 6,442,685, referred to as French hereinafter).

With regard to **claim 8**, Bourke-Dunphy discloses a *primary information handling system, included in a network of a plurality of information handling systems, comprising:*

*a processor* [any computer has a microprocessor, including one in Bourke-Dunphy];

*a memory coupled to the processor* [any computer of the type used to install Windows, as cited in Bourke-Dunphy has RAM and a hard disk];

*the network coupled to the processor and the memory, wherein the primary information handling system and the plurality of information handling systems use a substantially similar boot program* [In Bourke-Dunphy’s network, many client computers use the substantially similar

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boot program, specifically, those clients hosting Windows NT or Windows 98 (see lines 14-20, column 3));

a program stored in the memory, wherein the program is enabled to:

*read a service tag identifier uniquely identifying the primary information handling system*

[Netparam.ini (lines 1-13, column 8) is read as a “service tag” for configuring the new client computer],

*incorporate at least a portion of the service tag identifier to define a unique name record*

[the computer name in netparam.ini is used to name the computer (lines 1-13, column 8)];

*store the unique name record for the primary information handling system in the memory*

*of the information handling system* [During the installation, the step occurs automatically,

because the netparam.ini record is read into RAM for processing];

*transfer the unique name record to a name registry of the primary information handling*

*system* [After the installation, the compute name in RAM is stored in the Registry, see lines 10-22, column 8. Note that the Windows NT Registry contains the computer name that is updated during the client configuration];

*boot the information handling system from the substantially similar boot program used*

*by each of the plurality of information handling systems* [The step 98 in Fig. 17 illustrates the step of booting].

*read the name registry* [reading the registry is inherent during the boot of Windows NT.

This has been explained in the prior Office Action].

Bourke-Dunphy does not show, but French shows the following feature:

*broadcast the unique computer name record on the network to check for conflicts, and whereby if no conflict exists, the primary information handling system is recognized as a valid node on the network* [See from line 59, column 5 to line 59, column 6 for the general description of its use. Specifically, see lines 30-39, column 6].

It would have been obvious to one of ordinary skill in the art at the time of the invention to use NetBIOS in a local network to determine if a name of the host device is duplicated in the network, because French shows that NetBIOS maybe implemented for many operating systems including Windows NT (see Bourke-Dunphy), that operate in network systems.

With regard to **claim 9**, Bourke-Dunphy discloses *the plurality of information handling systems is configured to have a corresponding unique name record using a service tag identifier of each of the plurality of information handling systems*. Each of the new computer names is made from its corresponding netparam.ini file. Note the following inherent property of Microsoft BackOffice Small Business Server's Setup Computer Wizard (SCW): it forces each computer name on the network to be unique.

With regard to **claim 10**, Bourke-Dunphy discloses that *the definition of the unique name record occurs prior to the primary information handling system accessing the network*. After the client reboots (step 98, Fig. 17), the server on the network is accessed. Note that the client cannot access the network prior to the completion of the computer name configuration, which is part of the client network configuration. Also see lines 30-36, column 8.

With regard to **claim 11**, Bourke-Dunphy shows that the *definition of the unique name record for the information handling system occurs dynamically during a startup of the information handling system*. Fig. 17 shows how the configuration of the computer name record occurs during the “startup” (installation).

**Claims 15-18 and 20** list all the corresponding limitations of claims 8-11 and 13, but in software form rather than in apparatus form. The reasons for the rejections of claims 8-11 and 13 apply to claims 15-18 and 20.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ji-Yong D. Chung whose telephone number is (571) 272-7988. The examiner can normally be reached on Monday-Friday 9:30-6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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